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Amendment
Attorney Docket No. S63.2N-5605-US05

Remarks

This Amendment is in response to the Office Action dated February 12, 2007, wherein claims 11-12 were objected to; claims 17-19 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 5,935,161 to Robinson et al (Robinson); claims 17 and 20 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 5,449,373 to Pinchasik; claims 9-13, 16, 17, and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,102,417 to Palmaz et al (Palmaz); claims 17-19 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 5,514, 154 to Lau et al (Lau); and claims 9-16 were rejected under 35 U.S.C. §103(a) as being obvious over Lau in view of Palmaz.

The following comments are presented in the same order and with headings corresponding to the Office Action.

Claim Objections

In the Office Action claims 11 and 12 were objected to because the phrase "the difference in flexibilities" lacks antecedent basis from claim 9. Applicants have cancelled claims 11-12. Applicants reserve the right however to prosecute the subject matter of the claims in one or more continuation applications.

Claim Rejections – 35 USC §102

In the Office Action claims 17-19 were rejected under §102(e) as being anticipated by Robinson. More specifically the Examiner states that "Robinson anticipates the claim language where the peaks as claimed are the portions of the segments (33 and 35) that extend past the graft of Robinson; see Figure 3."

Applicants have included FIG. 3 of Robinson below for reference:

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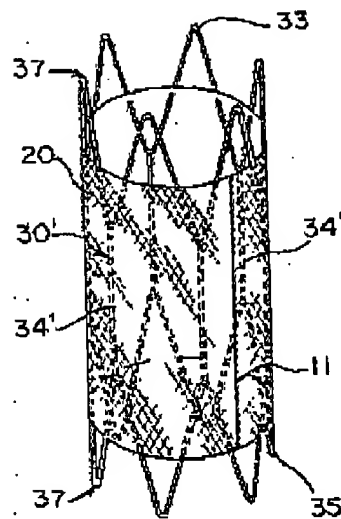


Fig.3

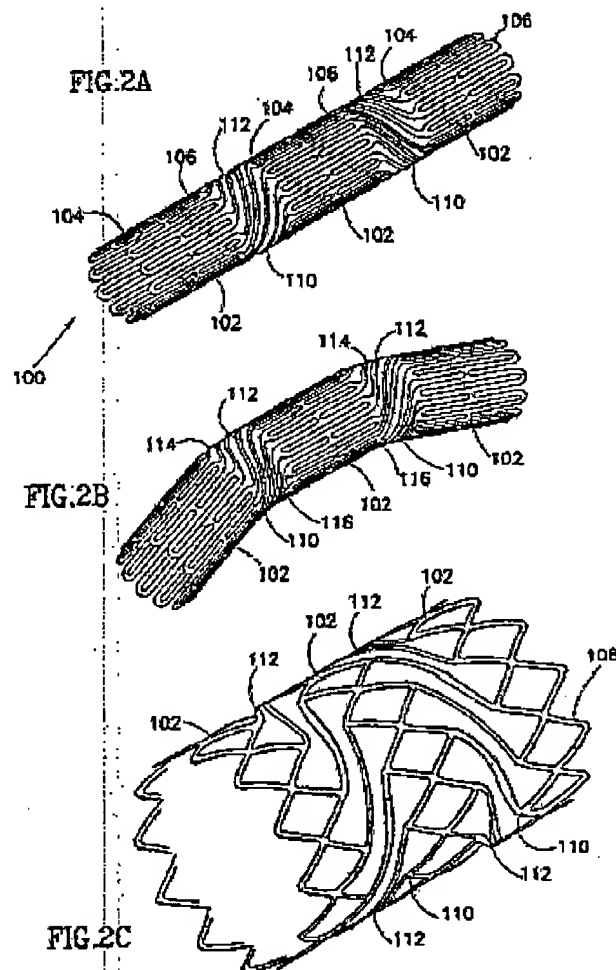
As stated above claim 17 is directed to a stent comprising a plurality of serpentine bands, wherein each band has alternating peaks and valleys. Adjacent serpentine bands are connected by connecting members. The stent has a plurality of cells, with each cell being defined by two connecting members and portions of two different serpentine bands. One of the portions is proximal to the other portion. The peaks of the proximal portion are offset circumferentially from the troughs of the distal portion relative to the circumference of the body.

Applicants are unclear how any of the characteristics described in claim 17 are disclosed by FIG. 3 of Robinson. Robinson provides two expandable segments 33 and 35 (column 6, lines 30-44). Nowhere does Robinson or the Examiner indicate any designation bands, connecting members, peaks, troughs or other features relevant to the instant claims. There is also no description in Robinson of the recited circumferential offset of the peaks of the proximal portion and the troughs of the distal portion. In light of the failure of Robinson to teach any aspect of the instant claims the rejection is respectfully traversed.

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In the Office Action claims 17 and 20 were rejected under §102(e) as being anticipated by Pinchasik. Specifically, FIGs. 2A to 2C were said to anticipate the claim language "of peaks of adjacent ends of the cell are clearly offset". FIGs. 2A to 2C of Pinchasik are reprinted below for reference.



As stated above, claim 17 is directed to a stent comprising a plurality of serpentine bands, wherein each band has alternating peaks and valleys. Adjacent serpentine bands are connected by connecting members. As shown in the reprinted figures, Pinchasik does not include these features. Instead the diamond shaped structures (102) illustrated best in FIG. 2C

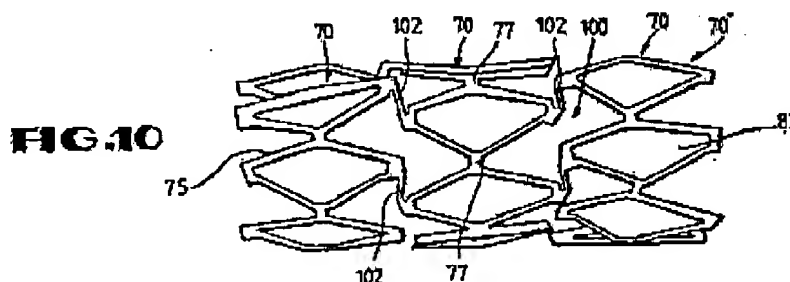
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are either bands that are directly connected one to the other without a connector or are a single structure which is clearly not serpentine in shape or configuration. Because of this clear difference between the structure of Pinchasik and the recitation of the instant claims the rejection is respectfully traversed.

In the Office Action claims 9-13, 16, 17 and 20 were rejected under §102(b) as being anticipated by Palmaz.

In regard to claims 16, 17 and 20 Palmaz fails to anticipate the language of the claims for reasons similar to the reason put forth in regard to Pinchasik above. Namely the structures shown and described in Palmaz do not include serpentine bands and/or connectors. To illustrate Applicants have reproduced FIG. 10 of Palmaz below:



As is clearly shown each of the cells 82 of Palmaz are completely enclosed by elements 70. As such, the elements 70 are arranged in a series of three non-serpentine closed cell bands connected by connectors 102, or that alternatively the elements 70 form serpentine bands that are directly engaged to one another without the use of connectors. Under either view Palmaz fails to disclose at least one element of the instant claims.

In regard to claim 9 and those claims dependent therefrom, claim 9 initially describes a stent having a plurality of annular elements, wherein each annular element has a compressed state and an expanded state, and each annular element is formed in a generally serpentine wave pattern containing alternating valley portions and peak portions. A plurality of connecting members connect adjacent annular elements to form a plurality of cells which are bounded at a first end by a portion of one annular element, at a second end by a portion of

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another annular element and two connecting members which extend between the one annular element and the other annular element. As is clear from this description, the cells of the instant claim are bounded by two connecting members and a portion of two adjacent annular elements. Palmaz does not describe such a stent. In Palmaz cells 82 are completely and exclusively defined by elements 70 and no connectors. While cells 100 do include both connectors and annular elements, the annular elements are not in the form of a serpentine wave pattern for the same reasons as discussed above.

Because Palmaz does not disclose all of the elements of any of the instant claims the rejection is respectfully traversed.

In the Office Action claims 17-19 were rejected under §102(e) as being anticipated by Lau. In putting forth the rejection the Examiner asserts that the end elements of the Lau stent depicted in FIGs. 11-13 inherently have less compression resistance than the intermediate elements because they do not have interconnectors connected thereto.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action has not provided any prior art reference, including Lau, which even discusses altering compression resistance of stent segments by the presence or lack of connectors. The Office Action has not provided any basis to support the assertion that changes in compression resistance of the stent segments necessarily follows the inclusion or lack of connectors connecting the segments. This is simply not an inherent feature of Lau or the references cited. As a result the rejection is respectfully overcome.

In the event that the Application is not allowed and further rejections are made, Applicants request that any teachings not explicitly contained within the applied prior art references be clearly supported with extrinsic evidence, and that such extrinsic evidence be provided to the Applicants.

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To the extent that any rejection is based upon assertions or 'information' within the personal knowledge of the Examiner, Applicant hereby requests that the Examiner support the rejections with an affidavit in accordance with 37 CFR § 1.104(d)(2).

Claim Rejections – 35 USC §103

In the Office Action claims 9-16 were rejected under §103(a) as being obvious over Lau in view of Palmaz.

In the Office Action the stated motivation to combine Lau and Palmaz is that "Palmaz teaches that it was known to make connectors extend at an angle...therefore it is the Examiner's position that it would have been obvious to make the connections of Lau (either the Figure 11 or 12 embodiment) extend at an angle offset the ends for the same reasons that Palmaz does the same."

In accordance with above, it appears that the motivation to combine Lau and Palmaz is based on the Examiner's belief, as opposed to an actual teaching or suggestion in the art as a whole. Neither of the cited references teach or suggest a desire to use the connectors of Palmaz with a stent design of Lau. Such motivation appears to be based solely on the Examiner's assertion of what one of ordinary skill would supposedly glean from Palmaz's use of angled connectors...as determined solely by the Examiner. This sort of conclusory statement without any actual teaching or suggestion in the references is not sufficient to establish a case of §103 obviousness.

While a suggestion or motivation to combine two references may come from the general knowledge of those of ordinary skill in the art, there must be actual evidence of such a suggestion or motivation and the showing must be clear and particular. In *re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) abrogated on other grounds, in *re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000); see also, *Smith Indus. Med. Sys. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999) ("That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge.") (emphasis in original); see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The conclusory statements of the Examiner fail to meet this standard. In *re*

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Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617 ("Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("[C]onclusory statements, however, are not sufficient to establish a genuine issue of material fact.")).

Regardless of the structural consequence of a hybrid formed of Lau and Palmaz, the Examiner has failed to provide sufficient motivation to even attempt such a combination. As a result the rejection is respectfully traversed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this Application is in condition for allowance. Favorable consideration and prompt allowance of claims 9-10 and 13-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: April 27, 2007

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